

Docket No. 030517

Serial No. 10/752,607

REMARKS

Claim 1-29 are pending in the present application.

Rejection under 35 U.S.C. 102(e)

Claims 1-4, 9-15, and 20-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolev, et al (U.S. Patent No. 6,125,283) ("Kolev").

The Applicant amends independent claims 1, 10, 12, 21, and 29 to overcome the Examiner's rejection under 35 U.S.C. 102(e). Since Kolev does not teach each limitation of the claimed invention, as now claimed in independent claims 1, 10, 12, 21, and 29, these claims are now allowable over Kolev. Further, since claims 2-9, 11, 13-20, and 22-28 are dependent on respective independent claims, these dependent claims are also allowable over Kolev. Therefore, since claims 1-29 are distinguished over Kolev, claims 1-29 are now in a condition for allowance, and the Applicant respectfully requests that the Examiner withdraw the present rejection.

Teachings of Kolev:

"A multi-mode mobile terminal having a subscriber identity is provided which uses knowledge of communications network supported service levels to navigate to a communication mode allowing the greatest possible service availability when the subscriber identity in at least one of the network modes is invalid. The mobile terminal may not only provide the ability to switch communication service from a current mode to an alternative mode to process emergency calls but may also restrict user operations on a communications network based on the services available without a valid subscriber identity. Operations of the mobile terminal invention may be supported by service level information on various communication service providers contained in memory within the mobile terminal or be obtained by the mobile terminal from the networks. Based on services availability information for each communications network available to the mobile terminal, the mobile terminal selects an appropriate network to utilize for a call initiated while the mobile terminal has no valid subscriber identification. An example of such a call would be an emergency call such as a 911 call." ("Abstract")

Docket No. 030517**Serial No. 10/752,607**

At col. 6, lines 18-67, with reference to FIG. 4, Kolev teaches that the user terminal 60 is a radiotelephone, such as a dual-mode radiotelephone, capable of communicating with the satellite communications system 40 and the terrestrial communications system 20.

In general, Kolev is concerned with whether or not a subscriber identity is valid or invalid.

Kolev does not teach or suggest the combination of limitations of each of the currently amended independent claims 1, 10, 12, 21, and 29, including, for example:

“receiving an origination request for a call, including parameters”

“automatically identifying the parameters in the origination request for the call responsive to receiving the origination request for the call”

automatically determining that the call is allowed on the selected communications network responsive to the origination request for the call, the parameters, and the information” and

“automatically” performing various functions.

Support for the present amendment may be found, for example, in paragraphs 20, 21, and 27 – 31. No new matter has been added by this amendment.

Rejection under 35 U.S.C. 103(a)

Claims 5-8, 16-19, and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolev in view of Feakes (U.S. Pub. 2003/0103607 A1) (“Feakes”).

As succinctly stated in the MPEP, to establish a prima facie case of obviousness, three basic criteria must be satisfied:

“First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and

Docket No. 030517

Serial No. 10/752,607

not based on the applicant's disclosure." Section 706.02(j) (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 706.02(j) (quoting *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)).

The Applicant amends independent claims 1, 10, 12, 21, and 29 to overcome the Examiner's rejection under 35 U.S.C. 103(a).

For the reasons set forth above, the Applicant submits that the combination of Kolev and Feakes does not teach or suggest all the claimed limitations in any of the currently amended independent claims or dependent claims.

In view of the foregoing, Applicant submits that all pending claims are in condition for allowance. Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

If there are any other fees due in connection with the filing of the response, please charge the fees to our Deposit Account No. 17-0026. If a fee is required for an extension of time under 37 CFR 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Docket No. 030517

Serial No. 10/752,607

Applicants therefore respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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